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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,140	11/04/2003	Tongbi Jiang	303.343US9	4829

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EXAMINER	
LAMB, BRENDA A	

ART UNIT	PAPER NUMBER
1734	

MAIL DATE	DELIVERY MODE
09/25/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/701,140	JIANG ET AL.	
	Examiner	Art Unit	
	Brenda A. Lamb	1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *9/13/2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6 and 8-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *1-4,8-10 and 13-21* is/are allowed.

6)☒ Claim(s) *5-6 and 11-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

The finality of the last office action is withdrawn and the rejection of the claims is set forth below.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6 and 11-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear how the recitation of the step of spreading a printable material onto the top surface of the stencil sets forth in claim 6 further limits independent claim 5 which is directed to a process for manufacturing a stencil. See Ex Parte Lyell 17 USPQ 1548 which states that two statutory classes cannot be claimed in the same claim such as instant claim 6. It is unclear how the recitation in claim 11 that the second coating is to control a running property of adhesive further limits the claim. Claim 12 is confusing due to a typographical error. The examiner suggests the following changes in order to overcome the above cited rejections: at lines 1-2 of claim 6 delete "further comprising spreading a printable material onto the top surface of the stencil," (the recited process step not limiting the claimed process directed to manufacturing a stencil); at line 2 of claim 6 delete "the spreading" and insert -- application --; at line 3 claim 6 before "top surface" insert -- coated --; at line 4 of claim 6 before "stencilling opening" insert -- coated --; at line 2 of claim 11 after "running property of an adhesive" insert -- applied to the coated stencil --; at line 1 of claim 12 change "stenciling" and insert -- stencilling --.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 5-6 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3,5-7 and 26-27 of U.S. Patent No. 6,521,287 (Jiang et al). Although the conflicting claims are not identical, they are not patentably distinct from each other because Jiang et al claims a process for constructing or manufacturing a stencil which is comprised of the following steps: forming a stencil pattern from a sheet of material impervious to the printable material and forming at least one stencilling opening therein; coating a top surface of the stencil pattem with a first coating having a surface tension greater than the surface tension of the stencil pattern; coating one or more side surfaces of the stencilling openings with the first coating having a surface tension greater than the surface tension of the stencil pattern; and coating the bottom surface of the stencil pattern with a second coating having a surface tension less than the surface tension of the stencil pattern. Although

Jiang et al fails to claim a sheet of material is impervious to the printable material, it would have been obvious the claimed stainless steel material is impervious to the printable material.

Claims 5-6 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3,5-7 and 26-27 of U.S. Patent No. 6,521,287 (Jiang et al). Although the conflicting claims are not identical, they are not patentably distinct from each other because Jiang et al claims a process for constructing or manufacturing a stencil which is comprised of the following steps: forming a stencil pattern from a sheet of material impervious to the printable material and forming at least one stencilling opening therein; coating a top surface of the stencil pattem with a first coating having a surface tension greater than the surface tension of the stencil pattern; coating one or more side surfaces of the stencilling openings with the first coating having a surface tension greater than the surface tension of the stencil pattern; and coating the bottom surface of the stencil pattern with a second coating having a surface tension less than the surface tension of the stencil pattern. Although Jiang et al fails to claim a sheet of material is impervious to the printable material, it would have been obvious the claimed stainless steel material is impervious to the printable material.

Claims 5-6 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 4 of U.S. Patent No. 6,368,897 (Jiang et al). Although the conflicting claims are not identical, they are not patentably distinct from each other because Jiang et al claims a process for constructing or

manufacturing a stencil which is comprised of the following steps:

forming a pattern in a stencil which obviously includes at least one stencilling opening therein to form a desired pattern on the substrate; coating a top surface of the stencil pattem with a first coating having a surface tension greater than the surface tension of the stencil pattern; coating one or more side surfaces of the stencilling openings with the first coating having a surface tension greater than the surface tension of the stencil pattern; and coating the bottom surface of the stencil pattern with a second coating having a surface tension less than the surface tension of the stencil pattern. Although Jiang et al fails to claim a sheet of material is impervious to the printable material, it would have been obvious the claimed stainless steel material is impervious to the printable material.

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Claims 1-4,8-10 and 13-21 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda A. Lamb whose telephone number is (571) 272-1231. The examiner can normally be reached on Monday-Tuesday and Wednesday-Friday with alternate Wednesdays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip Tucker, can be reached on (571) 272-1231. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brenda A Lamb
Examiner
Art Unit 1734